

**REMARKS**

This Reply is responsive to the Office Action<sup>1</sup> of October 29, 2007. Claims 1-17 were presented for examination and were rejected. Claims 1, 9, 10 and 17 are amended. Claim 8 is canceled without prejudice or disclaimer. No claims are added. Claims 1-7 and 9-17 are pending. Claims 1, 9, 11, 16 and 17 are in independent form.

Claims 1-17 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11, 13, 14 and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by “User sues Yahoo! for Revealing Identity” (hereinafter, referred to as “Yahoo”).

Claims 1-10, 12, 16 and 17 are rejected<sup>2</sup> under 35 U.S.C. § 103(a) as being unpatentable over Yahoo in view of Munsil et al., U.S. Patent 5,761,650 (hereinafter, “Munsil”).

These rejections are respectfully traversed for at least the following reasons.

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<sup>1</sup> The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant does not automatically subscribe to, or acquiesce in, any such statement.

<sup>2</sup> The Office Action rejects claims 11, 13-15 under 35 U.S.C. 102(b). Inconsistently, the Office Action, pg. 5 also says claims 1-17 are rejected under 35 U.S.C. 103(a). However, on pgs. 11-14 during the “103” analysis, it does not discuss claims 11, 13-15 consistent with the 35 U.S.C. 102(b) rejection. Applicant, therefore, assumes that the 35 U.S.C. 102 (b) rejection of claims 11, 13, 14 and 15 is intended and the 35 U.S.C. 103(a) rejection of these claims is not intended.

Claims 1-17 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Office Action alleges that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Office Action alleges that claims 1, 9, 11, 16 and 17 are all directed to connecting a plurality of customers sharing a common interest but does not enable one skilled in the art in how to determine which customers share a common interest. Applicant respectfully disagrees.

To the contrary, the application describes in lengthy detail how to determine which customers share a common interest. For example, a database is maintained, as depicted in Fig. 5 of the application, in which interests 508 of a plurality of customers are included. This database is built-up in response to server 102's (depicted in Fig. 1) receiving answers to individual customer's questionnaires. These interests 508 are associated with their respective customers, as shown. Customers having overlapping or common interests can be associated within a domain by operation of server 102 shown in Fig. 1; such operation is discussed, for example, in paragraph [0040].

In further detail, starting with act 208 in Fig. 2, a customer can register for a community of interest (COI) service. Each customer in the database may perform this procedure. This is discussed in paragraph [0031]. Each customer may go to a universal resource locator (URL) associated with a COI flyer received in the mail to register for a respective desired service. The detail of this registration is disclosed in Fig. 3 and in paragraphs [0032] - [0033] to which the Examiner is respectfully referred. This involves an on-line user profile questionnaire about each customer's areas of interest and other

personal information. The COI server 102 at telco 100 depicted in Applicant's Fig. 1 receives the various completed questionnaires, establishes an account for each such customer and sends logon information to the customer, after which the customer can use the respective desired COI service. This, of course, is done with respect to each customer who responds in this fashion.

In Fig. 4, server 102 can receive an inquiry from a particular customer with respect to the area of interest selected by that particular customer in act 402. This request is processed per Fig. 4, as discussed in paragraph [0034]. For example, in act 410, server 102 selects other customers in its database with criteria that match the particular customer's profile to form a group of customers with common interest, and maps the above-noted database entries to the aliases of the matching customers. Customer aliases 512 in the database of the customers in this particular group of common interest, including the alias for the inquiring customer, are distributed amongst the group by the server, thereby allowing communication with each other on an anonymous basis.

The detail of the database of Fig. 5 is discussed in paragraph [0035]. The server is depicted in Fig. 6 and is discussed in paragraphs [0036] - [0040]. In addition, a screenshot is depicted in Fig. 7 showing what an inquiring customer may see when attempting to join a COI group in this manner. Description of customer interaction with the screenshot is presented in paragraphs [0041] - [0044].

Applicant respectfully submits that all of the disclosure on this subject, as exemplified by the information referenced above, is more than adequate to enable one of ordinary skill in the art to understand how a determination is made regarding which

customers share a common interest. Accordingly, it is respectfully requested that the 35 U.S.C. § 112, first paragraph, rejection of claims 1-17 be withdrawn.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The billing statements are the customers' billing statements and this fact has been addressed by way of amendment to claim 1. Also, the same service provider antecedent basis issue has been addressed by way of amendment to claim 1. Applicant has, therefore, amended claim 1 to overcome this rejection. Accordingly, it is respectfully requested that the 35 U.S.C. § 112, second paragraph, rejection of claim 1 be withdrawn.

#### INDEPENDENT CLAIM 11 - REJECTION UNDER 35 U.S.C. § 102(b)

Claims 11, 13, 14 and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yahoo. Applicant respectfully disagrees for several reasons. MPEP § 2131 states that to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *See Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989).

To begin with, in considering this legal principle, and applying it to these claims, it is apparent that Yahoo does not anticipate these claims. For example, consider independent claim 11 which recites, *interalia*: “allowing others of said plurality of customers with access to said domain to have access only to said alias while keeping said true identity in confidence.” (emphasis added) For Yahoo to anticipate this claim, this claim element (along with all of the other claim elements) must be the express teaching, or inherent description, in Yahoo, but it is not.

In fact, the Yahoo reference expressly teaches the opposite - that the true identity of the user was not kept in confidence. Although maintaining a user’s identity in confidence may have been originally intended by the business organization operating under the Yahoo! company name, the particular publication upon which the Office Action relies as a reference to anticipate claim 11 clearly teaches that the user’s identity is not maintained in confidence. Indeed, the title of the reference itself tells the whole story: “User sues Yahoo! for Revealing Identity” - the publication clearly discloses that the identity of this customer has been revealed. Therefore this publication cannot read on “allowing others of said plurality of customers with access to said domain to have access only to said alias while keeping said true identity in confidence” because, in this instance, there was such access to such true identity which was not kept in confidence.

It is understood that the disclosure of the identity of this customer is in response to a legal requirement resulting from litigation. Nevertheless, to anticipate the claim, the reference relied upon must teach all claim elements and, clearly, this particular reference, under the circumstances disclosed in the reference, does not teach all claim elements at least for reasons given above.

Reinforcing Applicant's position, another legal principle is applied: MPEP 2141.02(VI), explains that a prior art reference must be considered in its **entirety**, i.e., as a **whole**, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). (emphasis added) When considering this legal principle with respect to this publication which is being relied upon to anticipate claim 11, it becomes even more clear that Yahoo (the instant publication) does not anticipate claim 11 because its entire teaching, the whole disclosure, leads away from the claimed invention. Indeed, the entire teaching and whole disclosure explains that a user's identity was NOT kept in confidence. For this reason alone, the 35 U.S.C. § 102(b) rejection of claim 11 should be withdrawn and the claim allowed.

In addition to the foregoing, Yahoo does not anticipate claim 11 for other reasons. The Office Action relies heavily upon "inherency" and Applicant respectfully disagrees that the reference inherently teaches what the Office Action alleges. Preliminarily, the Office Action's reliance upon "inherency" is an admission that the reference does not expressly disclose this limitation. According to MPEP 2131, to anticipate a claim, the reference must teach every element of the claim, which, admittedly, it does not expressly do. But, for a reference to inherently teach a claim element requires that it is "necessarily present" and not merely "probably present" in the reference.

Claim 11 recites, *interalia*: : "mapping said true identity to an alias associated with said at least one of said plurality of customers." Although it may be possible, or even probable, that a mapping exists between true identities and aliases in Yahoo, that particularly truthful mapping need not necessarily be the case in every instance. For

example, it is likely that Internet message board users have Internet email addresses that do not include their true names in the first place. In such cases, they can all be using aliases, at least in their IP addresses. Under these circumstances there is no reason to assume that true identities are being made available in all cases, much less available and “mapped.” Although mapping of true identities may be possible or probable, that isn’t good enough for an inherency rejection; mapping of true identities must be a certainty in every instance to meet an inherency rejection standard, which is not the case here.

Indeed, MPEP 2112(IV) sets forth the legal standard for a proper rejection relying upon inherency of disclosure in a reference. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” ” (emphasis added) In this instance, it is not sufficient that all users are probably using their true identities, or that those identities are probably available. For this reason alone, the 35 U.S.C. § 102(b) rejection of claim 11 should be withdrawn and the claim allowed.

The Office Action also relies on “inherency” to reject other elements of claim

11. For example, the Office Action also takes two claim elements of claim 11 together, namely: “accepting data from at least one of said plurality of customers, verifying a true identity of said at least one of said plurality of customers based upon at least a portion of said data” and again alleges that Yahoo inherently discloses these limitations. Applicant respectfully disagrees. For example, for the case where the data is not valid, for whatever reason, any conclusion including identity verification based on that data is not necessarily true. Again, although the probability of this scenario may appear to be small, it may not be small and, more importantly, any probability under 100% trumps an inherency rejection. “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” MPEP 2112(IV) For this additional reason alone, the 35 U.S.C. § 102(b) rejection of claim 11 should be withdrawn and the claim allowed.

Dependent claims 12-15 are allowable at least for reasons based on their respective dependencies from allowable base claim 11.

INDEPENDENT CLAIM 1- REJECTION UNDER 35 U.S.C. § 103(a):

Claim 1 is rejected under 35 U.S.C. § 103(a) as being un-patentable over Yahoo in view of Munsil. Claim 1 recites, *interalia*: “allowing at least a subset of said plurality of customers to communicate with each other using said domain while not disclosing true identity of each customer of said subset to others of said plurality by randomly associating, through operation of a server, said true identity of said each customer of said subset with a respective alias, said alias being made available to others of said subset to



identify respective ones of said subset.” (emphasis added) Yahoo in view of Munsil does not disclose or suggest at least this claim limitation.<sup>3</sup>

First of all, Yahoo, the cited publication, clearly teaches that the true identity of at least one customer has been publicly disclosed. This is the reason for the existence of the publication in the first place. This was discussed in detail above with respect to claim 11, and that discussion is incorporated by reference herein. Thus, Yahoo cannot read on at least the “while not disclosing true identity of each customer” portion of the above limitation. For this reason alone, the 35 U.S.C. § 103(a) rejection of claim 1 should be withdrawn and the claim allowed.

In addition, there is no discussion in Yahoo of any random selection or association of an alias by operation of a server as claimed. Accordingly at least this portion of this limitation is not disclosed or suggested by Yahoo. Furthermore, Munsil, cited for reasons related to notification to customers via invoicing and billing, does not cure this deficiency in Yahoo.

In accordance with MPEP 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

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<sup>3</sup> Support for the amendment to this claim limitation is in the application as originally filed; see, for example, at least canceled claim 8, paragraph [0042], and Fig. 7 and discussion associated therewith. Furthermore, Applicant does not acquiesce that Yahoo and Munsil are necessarily properly combinable in the first place.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. And, all three of these basic criteria must be met - if any one is not met the prima facie case of obviousness is not made. The first two criteria are not considered at this time because it is clear that a prima facie case of obviousness is not established on the basis of the third criteria, but Applicant does not acquiesce that the references are combinable in any event. In this instance, the prior art reference (or references when combined) do not teach or suggest all the claim limitations. Therefore, it is respectfully requested that the 35 U.S.C. § 103(a) rejection of independent claim 1 be withdrawn and the claim allowed.

Dependent claims 2-7 are likewise allowable, at least for reasons based on their dependencies from allowable base claim 1.

INDEPENDENT CLAIM 9 - REJECTION UNDER 35 U.S.C. § 103(a):

Claim 9 is rejected under 35 U.S.C. § 103(a) as being un-patentable over Yahoo in view of Munsil. Claim 9 recites, *interalia*: “wherein said server further comprises: authentication means for allowing at least one of said plurality to establish its identity; and associating means for mapping said identity to an alias randomly-generated and chosen by said server and associated with said at least one of said plurality, said alias being made available to other of said plurality having access to said domain, said alias further concealing true identity of said at least one of said plurality.” (emphasis added) Claim 9 has been currently amended to include certain of the limitations of dependent claim 10 and to include language directed to random generation and choice of the alias by the server. As previously noted (footnote #3 *supra*) this claim language is supported in

the application as filed. Yahoo does not disclose or suggest this limitation and Munsil does not cure this deficiency in Yahoo. Accordingly, Yahoo in view of Munsil does not disclose or suggest this limitation and, according to MPEP 2143 as noted above with respect to claim 1, a prima facie case of obviousness has not been established with respect to claim 9. For this reason alone, the 35 U.S.C. § 103(a) rejection of claim 9 should be withdrawn and the claim allowed.

Moreover, the Office Action does not cite ANY portion of ANY reference against Applicant's limitation: "authentication means for allowing at least one of said plurality to establish its identity" which is interpreted to mean that the Examiner admits that there is no disclosure or suggestion of this limitation in these cited references. Applicant agrees. Accordingly, the claim is allowable, by admission. For this reason alone, the 35 U.S.C. § 103(a) rejection of claim 9 should be withdrawn and the claim allowed.

Claim 10, dependent from claim 9, is also allowable, at least for reasons based on its dependency from allowable claim 9.

INDEPENDENT CLAIM 16 - REJECTION UNDER 35 U.S.C. § 103(a):

Claim 16 is rejected under 35 U.S.C. § 103(a) as being un-patentable over Yahoo in view of Munsil. Claim 16 recites, *interalia*: "a selection field for allowing said customer to choose a topic of interest, said topic of interest being linked to at least a subset of said persons sharing said common interest with said customer." This limitation is also interpreted (Office Action, pg 12) to be inherently disclosed because, allegedly, "one skilled in the art would recognize that there [are] a plethora of forums for different topics of interest available for a user to select from." But, the mere fact that there is

disclosed “one of Yahoo!’s chat boards for publicly traded companies” in paragraph #1 on page 2 of Yahoo does not mean that there was NECESSARILY a field provided for allowing this customer to select a topic of interest that was linked as recited. Although multiple chat boards are alluded to in Yahoo, that characterization, by itself, does mean that an appropriate selection field was “necessarily present.” Applicant agrees that such a selection field was PROBABLY available, but probabilities are not good enough.

As previously noted with respect to claim 11 above, MPEP 2112(IV) sets forth the legal standard for a proper rejection relying upon inherency of disclosure in a reference. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” ” (emphasis added) In this instance for claim 16, it is not sufficient that a selection field allowing a topic of interest was probably available. For this reason alone, the 35 U.S.C. § 103(a) rejection of claim 16 should be withdrawn and the claim allowed.

INDEPENDENT CLAIM 17 - REJECTION UNDER 35 U.S.C. § 103(a):

Claim 17 is rejected under 35 U.S.C. § 103(a) as being un-patentable over Yahoo in view of Munsil. Claim 17 recites, *interalia*: “providing said each customer with access to said domain and access to information about said interests of said other customers to permit said anonymous communication between said each customer and said certain of said other customers, said anonymous communication resulting from a like plurality of aliases each generated randomly by a server for, respectively, a different one of said plurality of customers, whereby said each customer knows said aliases and not true identities of said certain of said other customers.” (emphasis added) Yahoo and Munsil, taken individually or in any reasonable combination, do not disclose or suggest at least this limitation.

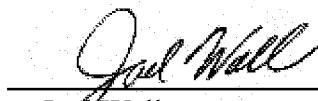
The Office Action (pg 13) cites Yahoo, page 2, paragraphs 1 and 4 against this limitation. These paragraphs of Yahoo, and all other paragraphs in Yahoo, do not even begin to hint at how these aliases are generated, much less disclose or suggest a server’s random generation of aliases. Munsil, cited for purposes of teaching notification to customers of a common domain by way of information included with respective billing statements, does not cure this deficiency in Yahoo. Accordingly, Yahoo in view of Munsil does not disclose or suggest this limitation and, according to MPEP 2143 as noted above with respect to claim 1, a prima facie case of obviousness has not been established with respect to claim 17. Therefore, it is respectfully requested that the 35 U.S.C. § 103(a) rejection of claim 17 be withdrawn and the claim allowed.

**CONCLUSION**

All rejections in the Office Action have been addressed. In view of the foregoing amendment and remarks, reconsideration and allowance of the pending claims are respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

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